Remarks

This Amendment is filed in response to the Official Action dated September 3, 2004. In this Amendment, claim 9 is amended to correct a typographical error, claims 21-36 are added and claims 10-16 are unchanged. Following entry of this amendment, claims 9-16 and 21-36 shall be pending.

I. Rejections Under 35 U.S.C. Section 103(a)

Claims 9-16 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 6,328,446 to Bhalakia et al. ("*Bhalakia*") in view of US 5,751,481 to Dalzell et al. ("*Dalzell*"). The applicant respectfully traverses these rejections.

The present invention relates to a method of making a polarized optical article that is superior to previously known methods. One of the ways success is achieved in this regard is by combining the concept of lamination with the concept of an injection molding process. Lamination facilitates a simpler optical element structure and injection molding tends to be more economical than most processes. The challenge in combining these two advantageous concepts, however, is to arrive at a lens that retains optically superior properties and which is structurally sound.

The present invention meets this challenge by proposing the use of a laminate in the form of a polarizing plate that is placed in the mold of an eye lens and which can withstand the rigors of the injection molding process. It further contemplates that the polarizing plate will include a protective layer that is substantially optically isotropic so as to retain the necessary optical properties in the finished polarized optical article.

In rejecting claim 9 of the invention, the Examiner has essentially taken the position that *Bhalakia* discloses the concepts of lamination and injection molding while *Dalzell* shows a polarizing element that uses a substantially optically isotropic protective layer. The Examiner thus asserts that it would have been obvious to use the teachings of a substantially optically isotropic protective layer in *Dalzell* with the lamination/injection molding process of *Bhalakia*. It is submitted, however, that this combination is overly simplistic and would not lead to a suitable optical article in any event. The reasons for this are explained below.

First, there is a fundamental difference in the starting points of *Dalzell* and *Bhalakia*. The laminate in *Dalzell* is a finished lens article whereas the laminate in *Bhalakia* is only a component of a finished optical article. Hence, the laminate in *Dalzell* would never be thermally fused to an injection molded thermoplastic lens base as in the claimed invention since the laminate in *Dalzell* already has a lens base. Therefore, there is no basis to assert that one of ordinary skill would be motivated to combine *Bhalakia* and *Dalzell* as the Examiner has asserted. The only conceivable basis to do so would be the present invention, which is, of course, improper hindsight.

Second, the process in *Bhalakia* and the process in *Dalzell* are fundamentally different. *Bhalakia* discloses a process whereby a polarizing laminate film is placed into a mold and molten lens material is then injection molded against the film. As such, the temperatures involved in this process are at or near the molten temperature of the thermoplastic power portion of the lens. *Dalzell*, on the other hand, discloses a shaping process whereby a lens blank having a lens base, a polarizing layer and an isotropic layer are pressed into a platen. As such, the *Dalzell* process occurs at or near the glass transition temperature of the lens blank which is much lower than the temperatures used in the injection molding process of *Bhalakia*. As a result, it would be quite counter-intuitive to one skilled in the art to use the optically isotropic materials taught by *Dalzell* (e.g., cellulose acetate, cellulose acetate-butyrate or cellulose triacetate) in the *Bhalakia* process because it would be expected that the more hazardous environment of the *Bhalakia* process would induce unacceptable birefringence in those materials. Indeed, given the thicknesses of the components in the *Dalzell* laminate, it is virtually certain that unacceptable birefringence would result if the *Dalzell* optical article were utilized in an injection molded process.

Finally, *Dalzell* itself teaches away from the process presently claimed. See, for example, column 2 lines 38-60. In this text, *Dalzell* discusses how an optically isotropic material is desired, especially on a polarized lens because of its non-rotatory affect on polarized light. *Dalzell* goes on to explain, however, that the forming method may induce strain and orientation in the light-transmissive layers, manifested by optical distortion and reduced polarizer efficiency. To address this concern, the remainder of *Dalzell* is spent teaching forming the lens in a press at low temperatures which by definition teaches away from the use of *Dalzell*'s optically isotropic protective layer to an injection molding process.

For all of the above reasons, therefore, it is submitted that the combination of *Bhalakia* and *Dalzell* cannot be properly maintained. It is further submitted that the rejection should therefore be withdrawn and that claim 9 is in condition for allowance.

With regard to claims 10-16, these claims depend either directly or indirectly from claim 9. Hence, for at least the reasons stated above, these claims are also in condition for allowance. However, these claims further define and describe the present invention and thus are patentable over and above the patentability of claim 9.

With regard to new claims 21-36 (claims 21 and 29 being independent), these claims also recite a method in accordance with the present invention and are fully supported throughout the specification. Moreover, the arguments as set forth above with respect to claim 9 apply equally to these new claims. Hence, for at least the same reasons, these claims are also submitted as being in condition for allowance.

CONCLUSION

In view of the foregoing, it is submitted that pending claims 9-16 and 21-36 are now in condition for allowance. Hence an indication of allowability is hereby requested.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: Feb. 3, 2005

James W. Inskeep, Esq.
Registration No. 33,910

INSKEEP INTELLECTUAL PROPERTY GROUP, INC.
1225 W. 190th Street, Suite 205
Gardena, CA 90248
Telephone: (310) 217-6220
Facsimile: (310) 327-0282

Customer No. 37,374